



Docket No.: 50435-015 (P2145)

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

LI GONG

Serial No.: 08/883,636

Filed: June 26, 1997

Group Art Unit: 2132

Examiner: D. Meislahn

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APR 12 2001

**OFFICE OF PETITIONS
DEPUTY A/C PATENTS**

For: LAYER-INDEPENDENT SECURITY FOR COMMUNICATION CHANNELS

PETITION TO THE GROUP DIRECTOR UNDER 37 CFR 1.181

Commissioner for Patents
Washington, DC 20231

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Technology Center 2100

Sir:

This Petition seeks reversal of the Examiner's holding that one drawing Figure be labeled Prior Art and of the Examiner's taking of "Official Notice".

In the Office Action of February 13, 2001, the Examiner required that Figures 1, 3 and 6 be designated with a label "Prior Art". Upon reconsideration, Applicant can properly label Figures 1 and 6 "Prior Art" with some changes to the language in the specification to keep the designation from being misdescriptive. Nevertheless, the Examiner required Applicant to label Figure 3 "Prior Art" because "Figure 3 is common in TCP/IP." This rationale is incorrect. Figure 3 identifies stream format utilized for the object output 218 stream and the input stream 220 of Figure 2. Figure 3 is not at a depiction of a TCP/IP format. Rather, as set forth on page 9 of the specification, lines 22-24, it is a format utilized in conjunction with a "stream" abstraction used in conjunction

with the invention. Accordingly, Applicants respectfully request that the Examiner's requirement that Applicant label Figure 3 to be prior art be reversed.

The Examiner has taken Official Notice as follows:

In the Official Action of August 29, 2000, on page 5, the Examiner said: "Official notice is taken that it is old and well-known to increase security by encrypting already-encrypted data, and encryption is sometimes performed in communication protocols." Applicant traversed this taking of Official Notice in the response of November 29, 2000, page 12.

In response to Applicant's traversal of the Examiner's holding of Official Notice, the Examiner, in the Office Action of February 13, 2001 stated:

"Applicant has attempted to challenge the Examiner's taking of official notice; however, Applicant has not provided adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the official notice. MPEP 2144.03. Therefor, the presentation of a reference to substantiate the official notice is not deemed necessary. The Examiner's taking of official notice has been Maintained [sic]. Please note though, that Elgamal teaches the features for which a reference has been requested."

The Examiner provided no indication of where, within Elgamal, a teaching of increasing "security by encrypting already encrypted data" occurs and none is apparent from a consideration of the reference. Similarly, he has not shown where "encryption is sometimes performed in communication protocols" within Elgamal.

MPEP 2144.03 says: "If the Applicant traverses such an assertion [of Official Notice] the Examiner should cite a reference in support of his or her position." Therefore, the Examiner's rationale that there is somehow a burden on Applicant to

provide "adequate information or arguments so that on its face, it creates a reasonable doubt regarding the circumstances justifying the official notice" is erroneous as a matter of Office policy. Further, the conclusion that "therefor [sic] the presentation of a reference to substantiate the official notice is not deemed necessary" is similarly erroneous. Further, the Examiner's pro forma indication of a reference, which does not appear to teach anything related to the subject matter for which the traversal of Official Notice was taken, is not sufficient compliance with MPEP 2144.03.

To exacerbate the situation, in the most recent Office Action, the Examiner inappropriately takes additional "Official Notice" as follows:

(page 5 of the Final Office Action) "Official notice is taken that it is old and well-known that Java is intended for networked/distributed environments and enables the construction of virus-free, tamper-free systems."

It may be factual that Java is intended for network/distributed environments. Whether or not it is well-known that Java "enables the construction of virus-free, tamper-free systems" is open to dispute. There is no indication as to who "intended" such a purpose for Java. Since the Examiner's entire argument for obvious is predicated upon modifying prior art references that would "enable the implementation of a virus-free, tamper-free system," Applicant is unwilling to concede such a purpose without the citation of a reference. The Examiner should provide a reference as set forth in MPEP 2144.03.

For the reasons indicated, Applicant respectfully requests that the Group Director direct the Examiner to provide a reference in support of his position as set forth in MPEP 2144.03.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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